

### **REMARKS/ARGUMENTS**

This amendment is filed in response to the Office Action mailed February 24, 2006. In this Amendment, claims 1, 21, 25, 38 and 39 are amended. Claims 30-37 have been withdrawn from consideration. Following entry of this amendment, claims 1-29, 38 and 39 shall be pending.

In the Non-final Office Action, claims 1-29, 38 and 39 have been rejected based on various grounds. The applicant hereby requests reconsideration of these claims in view of the amendments and reasons set forth below.

I. **REJECTIONS UNDER 35 USC § 112, SECOND PARAGRAPH**

Claims 38 and 39 are rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has asserted that “claim 38 is indefinite in that it is unclear exactly what the ‘reduced bleeding’ constitutes – ie, ‘bleeding’ from where/what—and what the bleeding is reduced from.” Applicant respectfully submits amended claim 38 which provides that the reduced bleeding recited in claim 38 recites a method of reducing polyurethane bleeding. Applicant believes that any prior indefiniteness regarding the reduced bleeding as recited in claim 38 has been corrected by this amendment and that the rejection should accordingly be withdrawn.

Also, the Examiner has asserted that “claim 39, line 1, “photochromic lens” should be – method - so that claim 39 is properly dependent on claim 38.” Applicant respectfully submits amended claim 39, canceling “photochromic lens” and adding “method,” so that claim 39 properly depends from the method recited in claim 38. Applicant believes that any prior indefiniteness regarding claim 39 has been corrected by this amendment and that the rejection should accordingly be withdrawn.

In view of the foregoing, it is submitted that any indefiniteness that may have existed in the claims is no longer present. Hence, withdrawal of all rejections under §112 is respectfully requested.

II. REJECTIONS UNDER 35 USC §103(A) AS BEING UNPATENTABLE OVER EITHER *BHALAKIA ET AL.* '459 OR '446 IN VIEW OF EITHER OF EUROPEAN PATENT APPLICATION 1,162,482 OR *NISHIZAWA ET AL.*

Claims 1-29, 38 and 39 were rejected under 35 U.S.C. 103(a) as being unpatentable over either of *Bhalakia et al.* '459 or '446 (hereinafter *Bhalakia*) in view of either of EP 1,162,482 (herein after EP) or *Nishizawa et al.* (hereinafter *Nishizawa*). The Examiner has asserted that "either primary reference discloses the basic claimed method of making an injection molded multi-focal lens by providing a photochromic insert, placing same in an injection mold and injecting lens material into the cavity to make a multi-focal lens." Further, the Examiner asserts that "essentially, the primary references lack a showing of employing the instant photochromic insert with a polyurethane layer having a thickness of 5-80 microns and a clear teaching that the resultant lens has a sharp segment line and reduced bleeding."

Applicant agrees that both *Bhalakia* references lack the showing of a method that both employs the claimed photochromic insert with a polyurethane layer having the claimed thickness and that results in a lens with a sharp segment line. However, the *Bhalakia* references are even more fundamentally deficient than conceded by the Examiner.

First, the *Bhalakia* references do not disclose any photochromic polyurethane layer, let alone as claimed herein. Specifically, the *Bhalakia* references only disclose either polyvinyl alcohol or cellulose acetate butyrate as functional film resins in all of their Examples (see, for instance, Examples 1-4, which reference the use of polyvinyl alcohol to form the polarization functional film; see also, for instance, Examples 5 and 7, which reference the use of cellulose acetate butyrate to form the photochromic functional film). Although *Bhalakia* discloses a urethane-based component (see, for example, the '459 reference at Column 10, lines 49-50; see also, for example, the '446 reference at Column 11, lines 61-62), this disclosure is made specifically with regard to adhesives, which are employed to bind the disclosed functional film layer to the first and optionally second resin layers of *Bhalakias'* disclosed laminate.

Secondly, the *Bhalakia* references are deficient in that they do not disclose any photochromic polyurethane having the presently recited thickness of from about 5 microns to about 50 microns. The *Bhalakia* references only disclose a possible functional film thickness ranging between about 0.5 microns and 2 microns, and more preferably between about 0.7 microns and 1 micron (see, for example, Table 1 at Column 11 of the '459 reference and at Column 12 of the '446 reference).

These distinctions between the present claims and the disclosures made in *Bhalakia* are material insofar as the use of a polyurethane layer having a thickness of about 5 microns to about 50 microns leads to reduction of polyurethane bleeding when making a photochromic lens and particularly aids in achieving a sharp segment line in a multifocal photochromic lens. These advantages are discussed throughout the present application. See, e.g., Application on page 6, paragraph 23.) Therefore, for at least these reasons, both *Bhalakia* references, whether alone or in combination, are deficient as to the presently claimed invention.

Nor are these deficiencies remedied by the EP and/or *Nishizawa* references. In fact, the EP and/or *Nishizawa* references are deficient in their own regard. For example, the Examiner asserts that the EP and/or *Nishizawa* references "teach injection molding a lens against a photochromic insert with a polyurethane layer of thickness 50-250 microns." However, the presently claimed invention is directed to a thickness of the polyurethane layer from about 5 microns to about 50 microns, which is thinner than the thickness disclosed in the EP and/or *Nishizawa* references. Moreover, when discussing the appropriate thickness, both the EP and/or the *Nishizawa* references state that "when the thickness is below 50 microns, color development is insufficient under irradiation of an ultraviolet light and contrast becomes low." See EP at paragraph [0027]; see also *Nishizawa* at column 3, lines 54-56. In other words, the EP and *Nishizawa* references explicitly teach away from the thickness range of the currently pending claims.

As another example of the deficiencies in the EP and *Nishizawa* references, it is noted that the only type of laminate disclosed therein is a laminate film having at least two functional layers, namely, a photochromic functional layer and a polarization

functional layer. This too is contrary to the presently claimed invention, insofar as the claims recite that there is only one functional layer, namely, a photochromic functional layer, in the photochromic insert. This distinction is important at least for the reason that a thicker insert (i.e., an insert that has more than one functional layer) will make it more difficult to create the sharp segment line in a multifocal lens as claimed.

In summary, it is clear that neither the *Bhalakia* references nor the *EP/Nishizawa* references, either singly or in combination with one another, disclose or suggest the presently claimed invention. Hence, it is manifest that these references cannot be a proper basis for rendering obvious the presently claimed invention.

As such, it is submitted that independent claims 1, 21 and 38 are therefore allowable. Furthermore, claims 2-20, 22-29 and 39 depend from allowable claims 1, 21 and 38 and are therefore allowable for at least the same reasons. However, these claims further define and describe the present invention and are patentable over and above claims 1, 21 and 38.

**CONCLUSION**

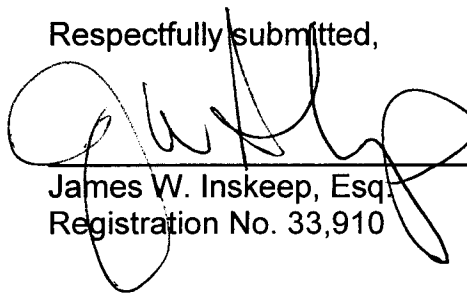
In view of the foregoing, it is demonstrated that none of the prior art cited anticipates or renders obvious, alone or in combination, currently pending claims 1-29, 38 and 39. Thus, it is respectfully requested that the Examiner withdraw all of the rejections and issue a notice of allowance of all claims.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

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